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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,505	05/02/2001	John C. Voudouris	72270-9004-01	8515

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EXAMINER	
LEWIS, RALPH A	

ART UNIT	PAPER NUMBER
3732	

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/847,505	VOUDOURIS, JOHN C.	
	Examiner	Art Unit	
	Ralph A. Lewis	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 October 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *41-57 and 59* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *41-57 and 59* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Rejections based on 35 U.S.C. 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 52 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 52, line 2, it is unclear how the shutter "end" relates to that already set forth in the parent claim 48. Dependent claims must reasonably relate back to the claims from which they depend.

Objection to the Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). The specification fails to define the "mesio-distal axis" set forth in claim 48.

Obvious-type Double Patenting Rejections

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 41-57 and 59 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over

claims 1-13 of U.S. Patent No. 6,257,883;

claims 1-22 of U.S. Patent No. 5,913,680; and

claims 1-15 of U.S. Patent No. 5,474,445.

Although the conflicting claims are not identical, they are not patentably distinct from each other because one of ordinary skill in the art would have found it obvious to have presented the earlier claimed orthodontic bracket in the broader terms of the present claims. Setting forth a previously claimed apparatus in broader claim language is obvious.

In response to the present rejection based on 6,257,883, rather than filing a terminal disclaimer applicant argues that there "is nothing in the claims of the '883 Patent that teaches or suggests the concept of a locking shutter positioned between the tie wings." The examiner disagrees, the patented claim of '883 calls for "at least one tie wing" to which one end of the "locking shutter is pivotally attached." The ordinarily skilled artisan would have readily recognized that "tie wings" typically come in pairs (in fact further patented dependent claims suggest such). Patented claim 1 of '883 fails to specifically state where or how the end of the locking shutter is attached to the "at least one tie wing." The ordinarily skilled artisan would have recognized that the physical

arrangement of a tie wing would allow for a pivotal attachment around the outer surface or to the side of the tie wing (i.e. "between the tie wings"). Merely selecting one of the two possible locations for the patented "shutter having one end pivotally engaged with said tie wing" would have been obvious to one of ordinary skill in the art.

In response to the present rejection based on 5,913,680, rather than filing a terminal disclaimer, applicant argues that "claims 1-22 of the '680 Patent do not teach or suggest a locking shutter positioned between the tie wings with a labial surface formed collectively by the body and the tie wings having a notch, the end of the locking shutter positioned in the archwire slot when the shutter is closed and the end of the locking shutter including a labial surface that is concave about an axis parallel to mesio-distal axis, or an end of the locking shutter positioned in a notch in the archwire slot when the shutter is closed." The examiner disagrees. Patented claim 2 clearly teaches an end of the locking shutter positioned in the archwire when shut. Patented claim 8 requires the bracket to have pairs of spaced apart occlusal and gingival tie wings, an archwire slot and a locking shutter pivotal about at least one pivot pin. The patented claim 8 does not expressly locate where that pivot pin is located, however, the ordinarily skilled artisan in practicing the invention would have found the locating of that pivot pin between space in the spaced apart tie wings as the only practical place positioning such a pivot pin. Merely filling in the obvious structural nuts and bolts of what applicant has previously patented would have been obvious to the ordinarily skilled artisan.

Likewise, with respect to 5,474,445, the examiner disagrees with applicant's remarks. The patented claims of '445 clearly teach a pivotal locking shutter (i.e. "latch")

within the scope of the pending claims. Applicant's remarks regarding 5,857,850 have found persuasive and the obvious-type double patenting rejection based on that reference is withdrawn.

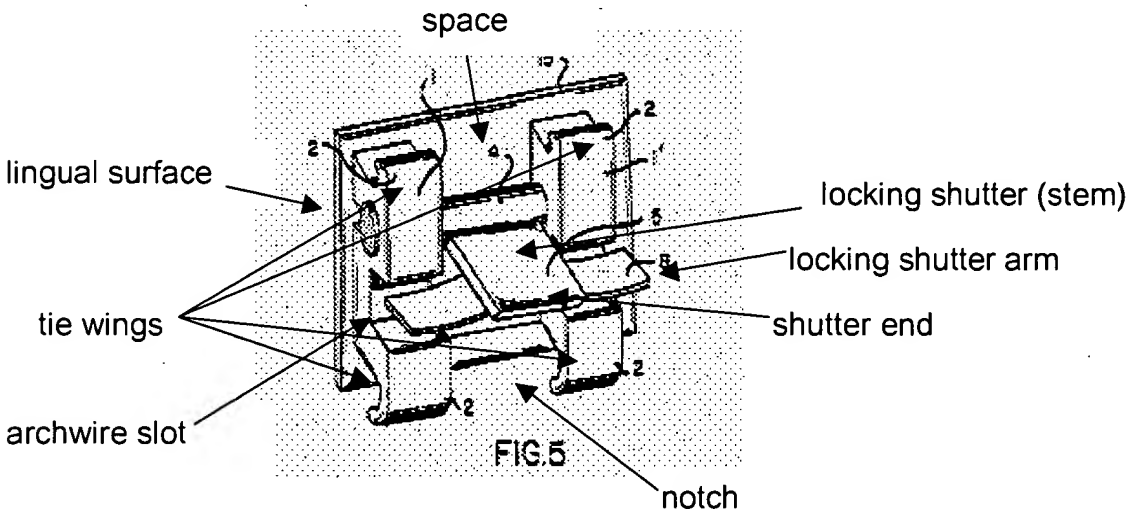
Rejections based on Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 41-57 and 59 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosenberg (4,634,662).

Note Figure 5 of Rosenberg reproduced below with identified elements meeting the claim limitations.



In response to the present rejection, applicant argues that "Rosenberg does not teach, suggest or disclose a body and tie wings collectively forming a labial surface having a notch formed therein." Perhaps applicant missed the word "notch" and accompanying arrow pointing to a "notch" in the Figure 5 provided by the examiner above as applicant did not even address the Figure provided. If applicant is of the position that the general terminology "notch" be interpreted much more narrowly, then it is suggested that the term be more narrowly defined in the claim. The examiner is required to give common terms such as "notch" their broadest reasonable interpretation.

Applicant further argues with respect to claim 48, that Rosenberg fails to disclose a labial surface that is "concave about an axis that is parallel to a mesio-distal axis." The examiner can find no basis for such "mesio-distal axis" language in the specification. In the Examiner's "Illustrated dictionary of Dentistry" by Jablonski, W.B Saunders Company, © 1982 no such terminology has been defined. The term "mesioaxial" is defined as "pertaining to or formed by the mesial and axial walls of a tooth cavity preparation" such language suggests a vertical axis for an upright patient. "Mesial" is defined as "toward or situated in the middle, median, nearer the middle line of the body or nearer the center of the dental arch." With no definition given for the terminology "mesio-distal axis" the examiner gives it its broadest reasonable interpretation as relating to a vertical axis and notes the Rosenberg Figure 5 device illustrated above includes concave surfaces on the locking shutter arm that meet the orientation requirement when in a closed position.

In regard to claim 54 applicant argues that "Rosenberg does not teach, suggest or disclose an archwire slot including a notch, or a shutter including an end positioned in the notch when the shutter is in the closed position." The examiner invites applicant to review the drawing reproduced above which illustrates elements distinctly labeled as "shutter end" and "notch" which expressly meets the physical limitation.

Action Made Final

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(571) 272-4712.** Fax (703) 872-9306. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Kevin Shaver, can be reached at (571) 272-4720.

Ralph A. Lewis
Primary Examiner
AU3732

R.Lewis
January 10, 2005